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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,806	03/30/2004	William S. Kerker	9974-077	6026
757	7590	03/10/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			MAI, THIEN T	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/812,806	KERKER ET AL.	

  

<b>Examiner</b>	<b>Art Unit</b>
Thien T. Mai	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 January 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9, 11-19, 21-30, 32-42, 44 and 45 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9, 11-19, 21-30, 32-42, 44 and 45 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.  |

## DETAILED ACTION

### ***Acknowledgement***

1. Acknowledgement is hereby made of the amendment filed 12/16/2005, in which claims 10, 20, 31, and 43 are cancelled.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim(s) 1-3, 5-9, 11-19, 22-30, 33-36, and 38-42 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (20020032612) in view of Junger (20040172260).

Regarding claim 1-3, 6, and 8, Williams discloses a system for return merchandise comprising:

- A merchant computer in network with a customer computer (Fig. 2)
- A first control logic for receiving merchandise identifier implicitly associated with the product description (Fig. 23a) and the quantity of merchandise being returned (Fig. 24)
- A second control logic for determining eligibility for return (Fig. 15)
- A third control logic for creating merchandise return form (Fig. 15, 24)
- A fourth logic for transmitting return form to the customer computer (Fig. 24)
- A fifth logic for receiving the edited return form (Fig. 26)
- A sixth logic for receiving an invoice identifier such as tracking number associating with the return transaction (Specification par. 0148. Fig. 71a, 43)

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Williams fails to disclose or fairly suggest the second logic having verification of merchandise being previously returned.

Junger discloses a logic for searching the merchant database for items to be returned/have been returned and display the return status on the screen as seen in Fig. 16G and on the RA Status screen as described in Specification par. 0113. Junger also describes a filtering logic that screens and tracks products that have been returned already to avoid multiple submissions of a single product for return (Specification par. 0122). Junger further discloses the identifier/serial number associated with a return item is also checked for duplicates to monitor problems and abuse (Specification par. 0090).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the method/logic of Junger to those of Williams with the motivation to avoid and spot possible problems or abuse of merchandise return policy.

Regarding claim 5 and 9, Williams discloses the sixth logic comprises customer being prompted to enter a reason from a list (Fig. 24) to be sent to the merchant (Fig. 48).

Regarding claim 7, Williams discloses the merchandise return being analyzed by SKU numbers (Fig. 61) inherently implies receiving them from customers.

Regarding claim 11, Williams discloses the fourth logic include displaying a quantity, merchandise identifier, description, a reason for return and an invoice identifier (Fig. 48)

Regarding claim 12, Williams discloses a label for printing and sent to the merchant (Fig. 27a)

Regarding claims 13-14, 17-18, and 22, see discussion regarding above claims.

Regarding claim 15, Williams discloses an inbound manager screen containing information regarding certain product(s) being returned including a quantity field (Fig. 58,

Specification par. 0497), which inherently implies there must be a way for the customer to enter quantity of products being returned.

Regarding claim 16, Williams discloses a merchandise SKU being provided by customer through the selection of a particular product being returned.

Regarding claim 17-19, 22, and 23, see discussion regarding claims above.

Regarding claim 24, Williams discloses the means for creating an unwanted merchandise return form is residing in the memory of an Internet server (Figs. 12-17) operated by a merchant or a common provider for the merchants (see Abstract).

Regarding claims 25-30, 33-36, 38-43, and 45, see discussion regarding above claims.

4. Claim(s) 4, 21, 32, 37, and 44 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (20020032612), modified by Junger as applied to claim 1 above, further in view of Walters (20050114221). The teachings of Williams have been discussed above.

Regarding claim 4, 21, 32, 37, and 44, Williams/Junger discloses all limitations set forth in the claims as discussed above, except for a seventh logic for transmitting the invoice having merchandise identifier to the customer computer for display.

Walters discloses an invoice transmitted from a merchant website computer to the customer computer showing a return order number, quantity, merchant name and address, and SKU number on the left of the product description and Return Authorization number (Fig. 4F).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to be encouraged for utilizing Walters' teaching with the motivation for providing a detailed invoice serving as a proof to the customer.

### ***Conclusion***

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5. Applicant's arguments filed 12/16/2005 have been fully considered but they are not persuasive.

6. On pages 11-13, Applicants wrote:

*Williams discloses a computer system that is configured to provide on-line stores a way for ecommerce customers to return merchandise purchased from the on-line store. More specifically, Williams discloses a system and method for a customer to return a product using a merchant return form on which the merchandise to be returned is Identified. However, Williams does not disclose determining whether the unwanted merchandise is eligible to be returned by searching the database of returned merchandise to determine whether the unwanted merchandise was previously returned and men creating a merchandise return for having the merchandise identifier of the merchandise eligible to be returned, as now claimed in amended claims 1, 13, 23 and 34.*

*Junger discloses an electronic registration system for authorizing product returns to reduce the incidence of improper returns. More specifically, the system and method of Junger is focused on minimizing or preventing fraudulent returns by identifying whether a person has purchased a new product with new packaging and then tried to return the new packaging with an old or different product for credit or return. The Junger invention reduces this type of fraud by requiring that the actual product be scanned rather than only the packaging returned with the product. During a product return the Junger system will recognize whether only the packaging serial number has been scanned and prevent acceptance of the return until the actual product is scanned, thus assuring that the actual product not just the packaging qualifies for return (see Junger, paragraph 76). Further, the system and method of Junger provides a method for returning customer presents the*

*sales receipt at the time of a return. the store associate may compare the serial number on the product with that on the sales receipt. The associate compares the printed serial number with that on the product itself, rather than the serial number on the packaging, to guard against repackaging of an old product in a box for a recently purchased product. If the serial number matches, the return is within an applicable allowable time period and all other return qualifications are met, i.e., no major parts are missing, the return may be accepted (see Junger, paragraph 93).*

*Junger, as pointed out by the Examiner, provides reports to locate trouble caused by malfunctioning retailer systems or attempted fraud. For example, these reports may include a pass/fail ratio for all returns by a particular retailer over a given time period, duplicate serial numbers may be located and listed previously registered serial numbers may be flagged, and cross-references may be made between the registration date and the date the product was returned to the manufacturer,*

*However, Junger does not disclose or suggest utilizing these reports to determine whether the unwanted merchandise is eligible to be returned by searching a database of returned merchandise to determine whether the unwanted merchandise whereby the merchandise was previously returned. The Junger reports are focused on locating trouble spots and monitoring potential retailer abuse not customer fraud during a return (see Junger, paragraph 90). Moreover, Junger only teaches that a return is accepted (or eligible to be returned) if the serial number on the product matches the invoice, the return is within an applicable allowable time period and no major parts are missing (see Junger, paragraph 93). Junger does not mention or suggest determining a product's eligibility to be returned by determining whether a product has been previously returned. In order to establish a prima fascia case of obviousness each and every*

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*limitation must be found in the applied references. Applicants assert that this burden has not been met for the reasons stated above. Thus, neither Junger nor Williams in combination or taken separately teach or suggest the present invention, as now claimed, in amended claims 1, 13, 23 and 34. Accordingly, Applicants respectfully request allowance of claims 1, 13, 23 and 34.*

The Examiner respectfully disagrees with the argument above in regard to whether the Junger system determines a product's eligibility for return by determining if it has been returned previously. As mentioned in the item 3 of the present Office action above, Junger system does have a logic that would screen out products that have been previously approved and/or returned to avoid multiple return request submission of a single product.

7. On page 13, Applicant wrote:

*Claims 4, 21, 32, 37 and 44 were rejected under 35 USC 1102 (a) as being unpatentable over Williams In view of U.S. Patent Publication No. 2005/0114221 of Walters (Walters).*

*Walters discloses an interface for a merchandise return system that allows one or more merchants to funnel their returns processing to a central returns processing center. More specifically, Walters teaches that the customer is prompted for information about the merchandise being returned and that the information may be used by the merchant to determine whether to authorize the return. For example, Walter teaches that information may be me reason for the return, whether the package is opened and whether the customer seeks a credit or a replacement. However, nowhere in Walters is it taught or suggested that the merchant determines whether the unwanted merchandise is eligible to be returned by searching a database of returned merchandise to determine whether the unwanted merchandise was previously returned. Thus, Williams, Junger nor*

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*Walters in combination or taken separately teach or suggest the present invention, as now claimed, in amended claims 1, 13, 23 and 34.*

The Examiner respectfully disagrees with the assertion that Williams, Junger, nor Walters in combination teach or suggest the present invention. The present Office Action has demonstrated that Williams, Junger, and/or Walters in combination anticipate every claim limitations set forth in the claims of the present invention.

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***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: **Gullo (US 2004/0044586)** discloses a method for processing refund request comprising a logic for verifying the transaction information associated with a product that whether it is previously refunded (see esp. paragraph 0019).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thien T Mai  
Examiner  
Art Unit 2876  
TM



THIEN M. LE  
PRIMARY EXAMINER